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Paper No. 18

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**JAN 29 2004**

**OFFICE OF PETITIONS**

In re Application of: : ON PETITION  
Mosis :  
Filed: 30 July, 2001 :  
Application No. 09/917,081 :  
Docket No.: JKM-101 :

This is a decision on the petition filed herein on 10 November, 2003, under 37 C.F.R. §1.137(b) to revive the above-identified application as abandoned due to unintentional delay.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

**NOTES:**

(1) The Power of Attorney filed contemporaneously with the petition hereby is acknowledged and accepted.

(2) In his papers, Petitioner has incorrectly identified the Art Unit—the correct listing is AU 3751.

**BACKGROUND**

The record indicates that:

- Applicant Joseph K. Mosis (Petitioner) failed to reply timely and properly to the non-final Office action mailed on 9 April, 2002, and due (absent extension of time) on or before 9 July, 2002;

- the application was deemed abandoned after midnight 9 July, 2002;
- on 13 January, 2003, papers were filed via FAX by an individual identified as Gabrielle Tetreault, Esq.,” but for whom there is neither a registration number listed with the Office nor a Power of Attorney executed by the Petitioner herein--and those papers were not entered;
- Notice of Abandonment was mailed on 24 June, 2003, and contained a discussion that the Petitioner herein might consider requesting the withdrawal of the holding of abandonment or alternatively petitioning to revive the application as having been abandoned due to unavoidable delay or unintentional delay;
- more than two months later, Mr. Mosis filed a petition alleging, erroneously, that: the Office agreed to withdraw the holding of abandonment (thus, reason for consideration under 37 C.F.R. §1.181); alternatively seeking revival of the application under 37 C.F.R. §1.137(a) because a reply was submitted, via Federal Express (Tracking No. 834671723937) on 5 July but not delivered until 12 July, 2002; and a document styled “Response to Office Action Summary Dated April 9, 2002” was submitted in the 13 January, 2003, FAX materials, and Petitioner indicated this was the required reply;
- on 15 September, 2003, the petitions under 37 C.F.R. §1.137(a) and as considered under under 37 C.F.R. §1.181 were dismissed;
- the instant petition was filed on 10 November, 2003, accompanied by a Power of Attorney (discussed above) and an Amendment.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>4</sup>

And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

#### Allegations as to the Petition

#### Alleging Unintentional Delay

Petitioner has submitted the petition with fee and the reply and has made the statement of unintentional delay.

### CONCLUSION

Petitioner has satisfied the regulatory requirements, and the petition under 37 C.F.R. §1.137(b) hereby is **granted**.

The instant file is forwarded to Technology Center 3700 for further processing.

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<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

<sup>4</sup> See: *In re Application of G.*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

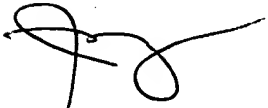
<sup>5</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 *Off. Gaz. Pat. Office* 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 *Off. Gaz. Pat. Office supra*.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Application No. 09/917,081

4

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.

A handwritten signature in black ink, appearing to read "John J. Gillon, Jr.", with a stylized, looping flourish extending from the end.

John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions